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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,422	12/06/2001	Anuschirwan Peyman	02481.1773	8208

7590 02/03/2003

Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
1625	7

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>10/004,422</b>	Applicant(s) <b>Anuschirwan et al.</b>
Examiner <b>Celia Chang</b>	Art Unit <b>1625</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jun 27, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-13 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-13 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. A preliminary amendment was filed in Paper No. 5, dated Dec. 6, 2001. Claims 1-13 are in the case.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 4-6, drawn to D is carbon compounds, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claims 1-3, 7-13 reading on the elected compounds can be prosecuted together with the election to the extend of the election.
- II. Claims 2-3 in part (not encompassed by group I), drawn to D is nitrogen compounds, classified in class 546, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claims 1, 7-13 reading on the elected compounds can be prosecuted together with the election to the extend of the election.
- III. Claim 1 remaining, drawn to D is O, S or subject matter not encompassed by groups I or II, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claims 7-13 reading on the elected compounds can be prosecuted together with the election to the extend of the election.

The inventions are distinct, each from the other because:

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Compounds of groups I-III are independent and distinct because the recited compounds possess variable core. The members of the recited Markush groups are so disparate chemically as to represent a plurality of classes for which the search and merit examination are not co-extensive. A reference anticipating any of groups I-III would not necessarily imply unpatentability of the other groups.

A telephone call was made to Mr. T. Rands on Jan. 17, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the groups and species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, then there could have been no patentability over WO 98/55260 which anticipated or rendered claim 1 obvious (see CA 129:10933 and RN attached).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

WP/Chang  
Jan. 29, 2003

*Cl - Ch*  
Celia Chang  
Primary Examiner  
Art Unit 1625